

No. 22,810

In the

FEB 24 1969

United States Court of Appeals
For the Ninth Circuit

HARLAN P. HAMLOW and HENRY RAPOPORT,
Plaintiffs-Appellants,

vs.

SCIENTIFIC GLASS APPARATUS CORP., a Corporation, and RINCO INSTRUMENT COMPANY, INC., a Corporation.

Defendants-Appellees.

Plaintiffs-Appellants Reply Brief

HENRY GIFFORD HARDY

1811 Mills Tower
San Francisco, California 94104
415/362-3361

*Attorney for Plaintiffs-
Appellants*

FILED

DEC 13 1968



TABLE OF CONTENTS

	Page
Plaintiffs-Appellants Reply Brief	1
The Findings of Fact	2
Infringement Has Been Proved	3
Invalidity Has Not Been Established	4
The Craig Apparatus Fails to Anticipate or Make Plaintiffs Inven- tion Obvious	4
Birchall Stopcocks Teach Nothing of Value Concerning Rotary Evaporators	5
The Deposition of Dr. Cava Is Useless to Destroy Plaintiffs Patent..	7
Defendants Have Not Sustained Their Burden of Proof of Prior Public Use	9
Conclusion	11

TABLE OF AUTHORITIES

	Page
Egbert v. Lippmann, 104 US 333; 26 L Ed 755 (1881)	9
Elizabeth v. Pavement Co., 97 US 126; 24 L Ed 1000 (1877).....	10
Tool Engineering v. Honcor, 367 F2d 449; 151 USPQ 236 (9th Cir-1966)	9

In the

United States Court of Appeals

For the Ninth Circuit

HARLAN P. HAMLOW and HENRY RAPOPORT,
Plaintiffs-Appellants,

vs.

SCIENTIFIC GLASS APPARATUS CORP., a Corporation, and RINCO INSTRUMENT COMPANY, INC., a Corporation.
Defendants-Appellees.

Plaintiffs-Appellants Reply Brief

Plaintiffs have received and studied the Brief filed by Defendants-Appellees. Three impressions are inescapably derived from a reading of the Brief:

1. The extent of the quotations from printed exhibits;
2. The extensive quotations from, and reliance upon the so-called Findings of Fact which have been fabricated by Defendants according to their own desires; and
3. Castigation of Plaintiffs counsel for the lack of knowledge of the law.

Only those matters directed to the issues in this case will be responded to.

THE FINDINGS OF FACT

The so-called Findings of Fact are literally the fabrication of Defendants attorneys. The actual and complete extent of the consideration given to this case by the trial court is set forth in the decision (R 509-511) which is set out in full in Appendix B of Plaintiffs Opening Brief. The shallowness and the limitations of this decision are plainly apparent. The trial court made it abundantly clear that nothing other than that which was stated was considered. Accordingly, everything else in the so-called Findings of Fact is solely the manufacture of Defendants attorneys in the effort to mold the decision to their own uses and purposes. Plaintiffs, of course, objected to these Findings (T 39) but without avail, and the Findings were signed without even so much consideration as a hearing. It is, therefore, submitted that this is not the kind of Findings contemplated by Rule 52 F.R.P.C. as they are not the Judge's Findings even by adoption. They are certainly not the kind of Findings which warrant consideration by this Court, or which can be relied upon in determining the rights of the parties on this appeal. A great portion of Defendants Brief is devoted to quotations from their own Findings and in relying so heavily upon them, Defendants are merely echoing their own biased views.

Possibly, Defendants considered that since Plaintiffs lost the case, everything should be "sock it to them". The Findings do reflect this attitude, but such a situation is not warranted here. Judgment was for Plaintiffs under 35 U.S.C. § 101 and 116 (R 447). It was not even true in the decision referred to in Appendix B. For example, the only basis for holding non-infringement was "the apparent required use of lubricant" (R 510; See Opening Brief pp 10, 11 and 15). In this connection, the trial court did not hold that a source of low pressure or vacuum was not in the Vapsilator, as Defendants claim (Reply Brief p 32). What was actually held is plainly stated (R 510-511).

"MR. MOORE: Your Honor, about the point of low vacuum source. That was another contention that we stated, avoided infringement because the claim calls for and there is no proof.

THE COURT: I think that it is fairly implicit in the advertising that the court could draw an inference that there is a low vacuum source.

MR. MOORE: There is no question that the device if used is to be so used but there is now proof that it has been so used. That is my point.

THE COURT: I do not think I am ready to so find in that respect."

The so-called Findings of Fact go far beyond, and are therefore Defendants extrapolations of the terse limits of the decision. Beyond those limits, the Findings are merely self-serving statements. Plaintiffs assert there is no substantial testimony to support these Findings.

INFRINGEMENT HAS BEEN PROVED

Under the heading of infringement, Defendants take Plaintiffs to task for stating that Dr. Dreiding's Swiss company in producing its "Vapsilator", produced a structure which is a Chinese copy of the combination of elements in Plaintiffs claim. They dally with this Court not only as a matter of semantics, but by taking a statement of counsel from the Opening Statement and treating it as evidence. In Plaintiffs Opening Brief, it was stated that the "Vapsilator" produced by Dr. Dreiding's Swiss Company is a Chinese copy of Plaintiffs claim (pp 2, 10, 32, 33). Plaintiffs have interpreted this to this Court as a statement that Defendants deliberately copied Plaintiffs apparatus. This we do not know and never asserted, besides, it is a matter of morality. Plaintiffs are not concerned with morality at this point, but only the facts, and the facts are that the Defendants "Vapsilator" is a structure which does

not follow any of the prior art, but which does precisely and exactly copy the structure and function of the elements of the claim in suit. This is a controlling circumstance. (See Opening Brief pp 14-20).

On page 31 of Defendants Brief, they point out that copying was impossible because the Agreement for distribution of "Vapsilators" in this country, dated September 21, 1965, (Plf Ex 16) was in existence prior to the issuance of Plaintiffs patent. This is nonsense. It is the unrefuted testimony that Plaintiffs equipment, following the disclosures of the patent in suit, were placed on sale November 1960 (R 46), which is some five years prior to the Agreement to which Defendants refer. There was ample time in which Defendants could have obtained Plaintiffs rotary evaporator prior to the manufacture of the "Vapsilator".

Infringement is so evident, particularly in view of the admissions of Defendants. (Opening Brief pp 15-16) that one wonders if Defendants can really be serious in pressing the point of non-infringement. There is no evidence to support any Finding directed to non-infringement.

INVALIDITY HAS NOT BEEN ESTABLISHED

The Craig Apparatus Fails to Anticipate or Make Plaintiffs Invention Obvious.

In the Reply Brief, the Craig device (Def Ex D) is relied upon to a very large extent, but only as interpreted by the obviously biased testimony of its financially interested witness, Dr. Dreiding (Brief p 3)—supplemented by their own concocted Findings (Brief p 2). The sophistry of Dr. Dreiding's testimony is exemplified in his cross-examination (R 419-425). Perhaps a fair and unmistakable way to demonstrate the misleading character of Defendants argument, is to picture both the Craig device and the device of the claim in suit. (See structures reproduced along side)

In the Craig apparatus, A is a flask with an elongated neck C which releases into the interior of the flask B at right angles to the

not follow any of the prior art, but which does precisely and exactly copy the structure and function of the elements of the claim in suit. This is a controlling circumstance. (See Opening Brief pp 14-20).

On page 31 of Defendants Brief, they point out that copying was impossible because the Agreement for distribution of "Vapsilators" in this country, dated September 21, 1965, (Plf Ex 16) was in existence prior to the issuance of Plaintiffs patent. This is nonsense. It is the unrefuted testimony that Plaintiffs equipment, following the disclosures of the patent in suit, were placed on sale November 1960 (R 46), which is some five years prior to the Agreement to which Defendants refer. There was ample time in which Defendants could have obtained Plaintiffs rotary evaporator prior to the manufacture of the "Vapsilator".

Infringement is so evident, particularly in view of the admissions of Defendants. (Opening Brief pp 15-16) that one wonders if Defendants can really be serious in pressing the point of non-infringement. There is no evidence to support any Finding directed to non-infringement.

INVALIDITY HAS NOT BEEN ESTABLISHED

The Craig Apparatus Fails to Anticipate or Make Plaintiffs Invention Obvious.

In the Reply Brief, the Craig device (Def Ex D) is relied upon to a very large extent, but only as interpreted by the obviously biased testimony of its financially interested witness, Dr. Dreiding (Brief p 3)—supplemented by their own concocted Findings (Brief p 2). The sophistry of Dr. Dreiding's testimony is exemplified in his cross-examination (R 419-425). Perhaps a fair and unmistakable way to demonstrate the misleading character of Defendants argument, is to picture both the Craig device and the device of the claim in suit. (See structures reproduced along side)

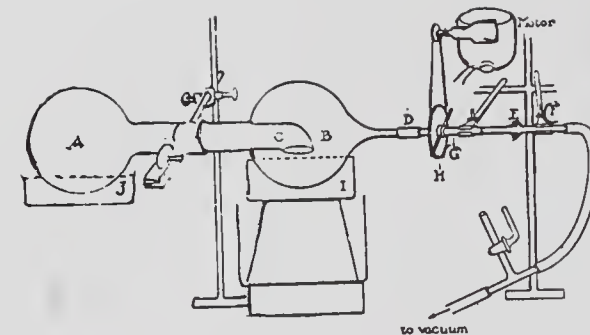
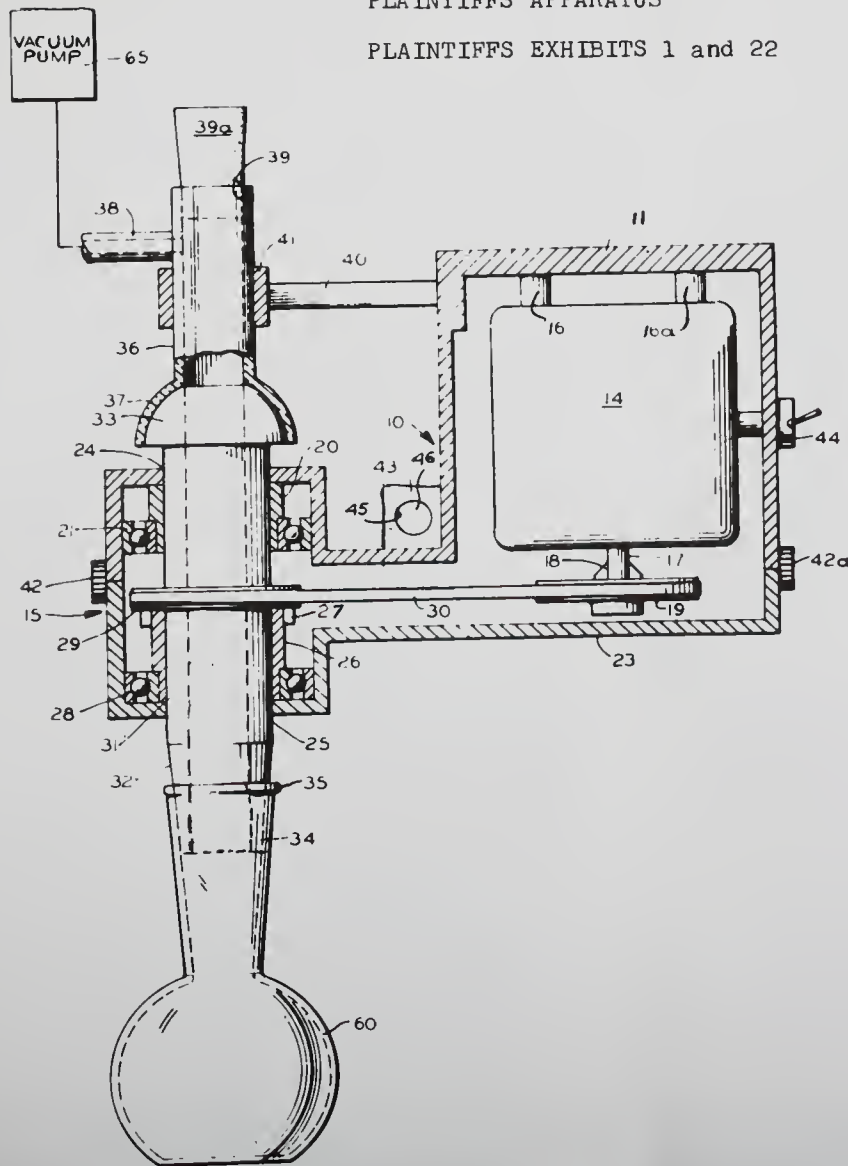
In the Craig apparatus, A is a flask with an elongated neck C which releases into the interior of the flask B at right angles to the

flow. The neck C is formed with and is an integral part of flask B. The material to be evaporated is placed in A. The vapor flows through the neck C and releases into the flask B. The material in flask B is condensed by the cooling in pan I (R 417). The narrow neck of the flask B is coupled to a glass tube G by a short length of rubber hose D (R 418). Thus, A, C, B, D, and G are rotated as a unit (R 417) by the motor and wheel H. E is "a standard ball joint". This is admittedly a glass to glass ball and socket joint which "For operation, joint E is well greased with a heavy stopcock lubricant and evacuation is begun." It is apparent from a comparison of the Buchler patent (R 419 Def Ex A-5) that this patent is merely a refinement of the Craig apparatus. It operates in precisely the same way with two simultaneously rotating globes and functions the same way. In the Craig article, the operation of the figure is from left to right, while in the Buchler patent drawing the operation is from right to left as shown.

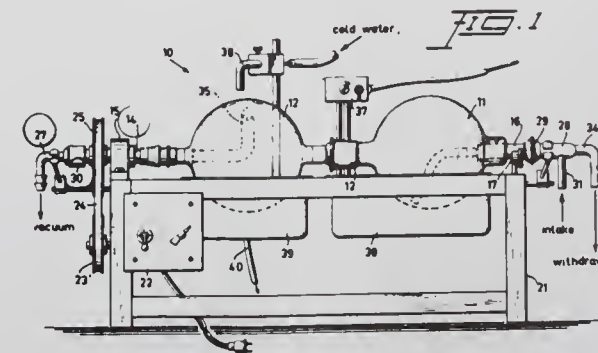
So far as consideration of the Craig article by the Patent Office is concerned, the determination of presumptive validity does not depend upon whether the article was cited, for by Defendants own standards, the Buchler patent is more pertinent than the Craig apparatus, and the Patent Office did consider the Buchler patent and, upon appeal, allowed Plaintiffs claim thereover (Def Ex K). The Craig apparatus could not function successfully because of the contamination of the rubber connection D and that of the lubricating grease on the joint at E (R 353, 407, 180). This was also true of Buchler (R 454). For a comparison of all of the art relied upon by Defendants compared element for element with the claim in suit, see Plaintiffs Appendix D at the end of the Opening Brief.

Birchall Stopcocks Teach Nothing of Value Concerning Rotary Evaporators.

Defendants disagree with Plaintiffs statement that the Birchall patent (Def Ex A-6), directed to stopcocks for laboratory glass-



CRAIG APPARATUS-DEFENDANTS EXHIBIT D



BUCHLER APPARATUS - DEFENDANTS EX A-5

ware, is non-analogous art. The fact that stopcocks are used in a laboratory does not teach the subject-matter of rotary evaporators, or any other piece of apparatus which may or could be used in a laboratory. Whether art is analogous or not is determined on the basis of structure. On the basis of the structure shown on the Birchall patent and the advertisements of Fischer & Porter Co. (Def Ex S and T), Plaintiffs submit that this is indeed non-analogous art. Whether it is or not, is really not of prime importance because the Birchall patent is not a disclosure of or a teaching which would make the subject-matter of Plaintiffs rotary evaporator obvious to one having ordinary skill in this art. Defendants assertion is not the equivalent of proof, and they offered no proof to support this assertion.

The glass seat of the stopcock is sloping or conical in shape. The Teflon plug is frusto conical in shape in order to conform with the angle of the seat. The very nature of Teflon, which presents a slippery surface, would cause the plug to slip out of engagement. Of and by itself, it could not remain in its seat as was customary when glass plugs were used. The Patentee Birchall himself says that it is an object of his invention to continuously urge the plug into wedging engagement within the seat by a steady pull of a compression spring or other means applied to the end of the plug axially thereof. The whole teaching of the Birchall patent is a structure for maintaining the Teflon plug on its seat by means of compression devices externally thereof (R 133) Therefore, the teaching of Birchall applied to Plaintiffs invention would be that if the tapered glass neck of a flask 34 were to be coupled to the taper 32 of Plaintiffs Teflon shaft 31, then the flask could not be held tightly thereon without some external means for continuously urging the same into the wedged engagement. No such teaching was or can be used in the apparatus of Plaintiffs claim. One of the unexpected benefits which

were achieved by Plaintiffs invention was the fact that this engagement remained air tight without external means, and in spite of differences in the co-efficients of expansion and contraction between the glass flask 60 and the Teflon shaft 31 (R 130). Since Birchall could teach nothing useful for rotary evaporators, it can hardly be considered the "most pertinent art".

The clincher is that when Dr. Dreiding was asked on cross-examination whether or not a serious study of the Birchall patent revealed anything like Plaintiffs rotary evaporator (Plf Ex 22), he said there was nothing in the Birchall patent "remotely resembling it" (R 432). This would seem to end any claim that Birchall taught anything which would make Plaintiffs invention obvious under 35 U.S.C. § 103.

It is therefore clear that not only is the Birchall patent not a teaching under 35 U.S.C. § 103 which would defeat the patentability of Plaintiffs claim, but that it was not the most pertinent art, so that the failure of the Patent Office to mention it does not defeat the presumptive validity of Plaintiffs claim.

The Deposition of Dr. Cava Is Useless to Destroy Plaintiff's Patent.

Apparently, Defendants rely upon the deposition of Dr. Cava of Wayne State University (Detroit, Michigan) to invalidate Plaintiffs patent. Any reliance upon the deposition of Dr. Cava is tantamount to the denial of the right of Plaintiffs to cross-examination. Time and again, Dr. Cava made statements from "memory" under the prodding of Defendants counsel. Defendants well know, that there should have been some supporting evidence to confirm facts and dates supposedly testified to by Dr. Cava. Time and again, Dr. Cava was asked upon cross-examination, to produce *any* supporting data of *any* kind. Each time he could not do so. He finally admitted that he had nothing whatever to support what he had said (R 293, 294, 232, 234, 236, 241, 248) and that he was not a mechanic (R 224) so his memory of equipment

was not good. He had no independent memory of the Bernauer apparatus (R 229). He did, however, have files (R 220). Defendants did not call anyone from either Ohio State University or Wayne State University who could have given supporting evidence that they saw the equipment or that Dr. Cava had brought it in or anything which could give credence to his memory. Nothing like this was done. No shipping documents, no photographs, no written records of any kind were offered in support of Dr. Cava's asserted dates. The Hormuth brochure on the Bernauer equipment (Def Ex Q) bears no date, and no proof was ever offered to make this a publication of probative value.

Furthermore, Dr. Cava was obviously indebted to his friend and mentor Dr. Dreiding. He continually, in the deposition, protested his lack of interest and bias loudly and, at times, vociferously (R 232, 239, 247, 221, 289). "Methinks he doth protest too much".

So far as Plaintiffs are advised, the trial court placed no credence whatever in Dr. Cava, or his deposition. Certainly nothing concerning him is referred to in the decision. Here is another example where Defendants prepared Findings on matters which were not included in the decision of the trial court.

Most important of all is that Dr. Cava could not place the date of his use of the Bernauer equipment accurately in 1959 or 1960 (R 232). If the use was actually after August 11, 1960, then it was too late to be useful to Defendants. Clearly this testimony does not conform with the standards required to defeat a valid U.S. patent.

Not only is there no proof by Defendants that the Bernauer Gebrauchsmuster and equipment are the same as that called for in Plaintiffs claim, but the evidence is all to the contrary.

Defendants Have Not Sustained Their Burden of Proof of Prior Public Use.

If Defendants rely to any extent on the deposition of Dr. Cava to show public use of the invention through the Bernauer apparatus, then this attempted proof fails for two reasons: *First*, there is no showing that the Bernauer apparatus is the same in structure as called for by Plaintiffs claim; and *Second*, that this deposition is wholly unreliable and uncorroborated to any degree.

This leaves only the use of Plaintiffs apparatus by the 12 graduate students of Dr. Rapoport at the University of California at Berkeley. This is a question of fact and the only facts are those which are found in the record, amounting to some eleven pages (See Opening Brief p 20). Plaintiff submits that these facts, under the law, do not establish public use.

Defendants rely upon *Egbert v. Lippmann* 104 US 333; 26 L Ed 755 (1881). In this case the criteria used by the Court was whether the inventor had "given or sold" the product of the invention to a third person. There is no question that these 49 machines were not sold. Equally, there can be no doubt that the apparatus was not given to the graduate students. These machines were at that time and always have been the property of the University of California (R 99). The use was not without limitation: the apparatus was for use only in the private laboratory of each graduate student on the premises; under Dr. Rapoport's direction and control (R 43); each such student was required to give a full report of the operation of his apparatus to Dr. Rapoport (R 43) which was quite independent of the work on the graduate thesis (R 97).

There was no "sale or gift" of this apparatus as there was in *Tool Engineering v. Honcor* 367 F2d 449; 151 USPQ 236 (9th Cir. 1966).

Defendants rely upon the time when an apparatus was "perfected" as the date when public use starts. This is not the criterion, and Defendants cite no authority in support of this phantasy* Dr. Rapoport was wise enough to realize that the reports of one of the inventors (R 42) was not sufficient testing in order to release the apparatus to the public, and that further testing was required (R 100). Testing by his graduate students was decided upon because of the scope of projects amongst them and because it could be wholly controlled by him. There should be no penalty for being thorough and sure before a product is sold in commerce and indeed the law does not impose such a penalty. The whole purpose of experimental use in the law is to provide the inventor with a reasonable testing period. That is all that was done here, as demonstrated by the testimony of Dr. Rapoport.

**Elizabeth v. Pavement Co.* 97 U.S. 126; 24 L.Ed. 1000 (1877) makes it plain that no changes or improvements have to be made: (p. 135)

"And though, during all that period, he may not find that any changes are necessary, yet he may be justly said to be using his machine only by way of experiment;"

CONCLUSION

In spite of arguments pro and con, several facts stand above all else.

- (1) Infringement has been proved beyond doubt.
- (2) Defendants admit that no patent or publication cited by them teaches or discloses Plaintiffs invention.
- (3) Defendants have not sustained the burden of proof of prior public use.
- (4) Defendants only witness and expert has a very substantial financial interest in the outcome of this litigation.
- (5) Plaintiffs invention was not obvious even to Plaintiffs expert skilled in this art who is familiar with all of the art relied upon.
- (6) Defendants commercial machine is a Chinese copy of the structure of Plaintiffs claim and therefore does not follow the prior art on which Defendants now rely to defeat Plaintiffs claim.
- (7) Plaintiffs products made under the claim in suit have had great commercial success.

If Plaintiffs claim, which is here in suit, is of sufficient importance for Defendants to identically follow, over everything else known in this art, it must be apparent that Plaintiffs have made a substantial contribution and that the decision and judgment of the trial court must be reversed.

Respectfully submitted,

HENRY GIFFORD HARDY

1811 Mills Tower
San Francisco, California 94104
415/362-3361

*Attorney for Plaintiffs-
Appellants*

